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| 09/929,035 | 08/14/2001 | Peter H. Gien | 10003-036-999 | 1909 |
| 20583 | 7590 | 11/23/2005 | EXAMINER | |
| JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017 | | | GURSHMAN, GRIGORY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2132 | |

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,035

Applicant(s)

GIEN ET AL.

Examiner

Grigory Gurshman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's amendment of claims 1-48 mainly reflects replacing the limitation "Web application" with "an executable software program". The amended claims are addressed in the rejections herein.
2. Applicant's arguments have been considered, but are ^{most} ~~not~~ in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Godfrey (U.S. Patent No. 6,363,479 B1).
5. Referring to the instant claims, Godfrey discloses a system and method for signing markup language data (see abstract). Referring to the instant claims, Godfrey teaches an apparatus, which facilitates digital signing of data communicated between a first unit and a second unit through an interface independent proxy, or multiple

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independent proxies, interposed between the first and second units. The independent proxy has a digital signature initiation data detector to detect embedded signature initiation data in data to be signed. The independent proxy contains a signature generator through which the form based communication data flows. Initiation data is used in the communication data to automatically trigger the intermediary or independent proxy to sign the communication data (see abstract and Fig. 1).

6. Referring to the independent claims 1 and 21, the limitation “a browser; coupled to the browser a signing module; and coupled to the browser and to the signing module, a signing interface” is met by unit 1 (104 in Fig. 1) comprising a web browser coupled to the unit 108 (in Fig. 1) comprising digital signature generator (118) and an interface in a form of digital signature initiation data detector(116). The limitation “the signing interface adapted to be invoked by an executable software program transmitted to the browser from the remote location” is met by the application transmitted from the remote web server (unit 106 in Fig. 1). Application is an executable software program.

The limitation “forwarding data to be signed by the signing module” is met by unit 108 (link 124), which illustrates forwarding data to digital signature generator. The limitation “receiving at the signing interface a digital signature for data to be signed from the signing module” is met by receiving the data at unit 116 from unit 120. The limitation “forwarding the digital signature to a remote location specified by the executable software program” is met by sending the generated signed transaction from proxy to unit 110 (i.e. remote location) via link 128 – see Fig. 1.

7. Referring to claims 5-7 and 25-27, Godfrey teaches the use of signature as mark up language tags (see block 414 in Fig.4).
8. Referring to claims 8 and 28, Godfrey teaches that data to be signed is retrieved from a remote location (see units 112 and 114 in Fig.1).
9. Referring to claims 9 and 29, Godfrey teaches that data to be signed is included in the application (i.e. executable software program) - (see units 104 and 108 in Fig.1).
10. Referring to claims 1 and 30, Godfrey inherently teaches digitally signing data with the key, because he teaches the use of digital signature technology, which cannot be performed without the key.
11. Referring to claim 16, Godfrey inherently teaches a signing interface comprising the user interface part, because he teaches the signing interface used by the user.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 41- 48, are rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey (U.S. Patent No. 6.363.479 B1) in view of Gibbs (U.S. Patent No. 6.085.321). Referring to the instant claims, Godfrey discloses a system and method for signing markup language data (see abstract). Referring to the instant claims, Godfrey teaches an apparatus, which facilitates digital signing of data communicated between a first unit

and a second unit through an interface independent proxy, or multiple independent proxies, interposed between the first and second units. The independent proxy has a digital signature initiation data detector to detect embedded signature initiation data in data to be signed. The independent proxy contains a signature generator through which the form based communication data flows. Initiation data is used in the communication data to automatically trigger the intermediary or independent proxy to sign the communication data (see abstract and Fig.1).

14. Referring to the independent claims 41 and 45, the limitation “a browser; coupled to the browser, a signing module; coupled to the browser and to the signing module a signing interface” is met by unit 1 (104 in Fig. 1) comprising a web browser and unit 108 (in Fig.1), comprising digital signature generator (118) and an interface in a form of digital signature initiation data detector (116).

Referring to claim 41, the limitation “the signing interface being adopted to facilitate access to system services provided via a four-corner model” is met by unit 116 (in Fig.1). The limitation “means for downloading an executable software program..” is met by proxy (unit 108 in Fig. 1). The limitation “a first participant, a second participant” is met by unit 1 and unit 2 (see Fig.1, 104 and 106). The limitation “forwarding data to be signed by the signing module” is met by unit 108 (link 124), which illustrates forwarding data to digital signature generator. The limitation “receiving at the signing interface a digital signature for data to be signed from the signing module” is met by receiving the data at unit 116 from unit 120. The limitation “forwarding the digital signature to a remote location specified by the executable software program” is met by sending the

generated signed transaction from proxy to unit 110 (i.e. remote location) via link 128 - see Fig. 1.

15. While Godfrey teaches forwarding the data to be signed to the signing module, he does not explicitly teach that the data is forwarded to the signing module after receiving a response to a service request. Referring to the instant claims, Gibbs discloses a unique digital signature (see title and Fig.1) used for the WWW transactions (see Fig.4). Gibbs teaches that the service id 104 is tested to verify that it represents a valid local username or service name. If the service id 104 is not valid, then the request for service is rejected. If the service id 104 is valid, then processing continues and data is signed (see Fig.1 and column 8, lines 50-55).

16. Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the signing system of Godfrey, which forwards the data to be signed to the signing module, by adding the means for verification of service request prior to signing the data as taught in Gibbs. One of ordinary skill in the art would have been motivated to modify the signing system, which forwards the data to be signed to the signing module, by adding the means for verification of service request prior to signing the data as taught in Gibbs for creating a unique digital signature which includes service id (see Gibbs abstract and Fig.1).

17. Referring to claims 43, 44, 47, 48 it is well known in the art of internet transactions to provide warranty in response to a service request. For example buyers on line request product warranty, which is transmitted in digitally signed form. One of

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ordinary skill in the art would have been motivated to send the product warranty in the digital form for online transactions.

18. Claims 11, 12, 31 and 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey (U.S. Patent No. 6.363.479 B1) in view of Dancs (U.S. Patent No. 6.385.651).

19. Referring to the instant claims, Godfrey discloses a system and method for signing markup language data (see abstract). Referring to the instant claims, Godfrey teaches an apparatus, which facilitates digital signing of data communicated between a first unit and a second unit through an interface independent proxy, or multiple independent proxies, interposed between the first and second units (see abstract and Fig. 1).

20. Godfrey, however, does not explicitly teach that digitally signed data includes smart card and signature security data. Referring to the instant claims, Dancs shows a smart card internet system (see Fig. 1). Dancs teaches that all data on the smart card 102 is written including the digital signature of the author of the data.

21. Therefore at the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the signing system of Godfrey, which forwards the data to be signed to the signing module by having digitally signed data including smart card security data as taught in Dancs. One of ordinary skill in the art would have been motivated to modify the signing system, which forwards the data to be signed to the

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signing module, by having digitally signed data including smart card security data as taught in Dancs for verification of data integrity.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grigory Gurshman whose telephone number is (571)272-3803. The examiner can normally be reached on 9 AM-5:30 PM.

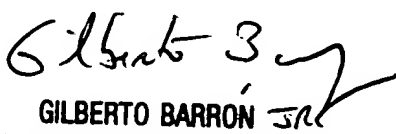
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571)272-3799. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GG



Grigory Gurshman
Examiner
Art Unit 2132



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